

REMARKS

Applicants request reconsideration and allowance of the present application in view of the amendments to the claims and following remarks.

Claims 1-9, 12-26 and 28-45 remain pending. Claims 1, 28, 29 and 45 are independent claims.

On page 2 of the Office Action, the Examiner objected to the specification as failing to provide proper antecedent basis for the phrase “computer readable medium” recited in claim 45.

It is well established in the patent law that 35 U.S.C. Section 112 does not require that a specification describe an invention in words identical to the patent claims. For example, in *In Re Wright*, 866 F. 2d 422, 9 U.S.P.Q. 2d 1649, 1651 (Fed. Cir. 1989), the Court of Appeals for the Federal Circuit held that a rejection by the Patent Office of an amendment to claims which sought to introduce the words “not permanently fixed” added after the original filing was an error. In that case, the involved specification made it very clear that two elements were not fixed to one another, i.e. one element was removable. Therefore, the Applicant was perfectly within his right to use the phrase “not permanently fixed” to describe his invention in the claims, even though that precise phrase was not in the original specification.

In the present case, Applicants submit that a computer readable medium is disclosed in at least paras. [0035], [0036], [0040] and [0041], each disclosing, for example, “storage 17.” Withdrawal of the objection to the specification is respectfully requested.

On pages 2-3 of the Office Action, the Examiner rejected claim 29 under 35 U.S.C. § 101. Claim 29 has been in a manner that it believed to overcome the rejection under 35 U.S.C. § 101. Withdrawal of the rejection of claim 29 is respectfully requested.

On page 3 of the Office Action, the Examiner objected to claim 28 under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 1. Claim 28 has been amended. Withdrawal of the objection to claim 28 is respectfully requested.

On pages 4-24 of the Office Action, the Examiner rejected claims 1-2, 9, 12-14, 16-23, 25-26, 28-41 and 45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,792,145 (“Gay”) in view of U.S. Publication 2006/0167772 (“Zilberman”), and further in view of U.S. Patent No. 5,860,071 (Ball). On pages 25-32 of the Office Action, the Examiner rejected claims 3-8, 15, 24 and 42-44 under 35 U.S.C. § 103(a) over Gay, Zilberman, Ball, and U.S. Publication 2004/0230892 to Horton.

Applicants incorporate by reference the remarks pertaining to the Gay, Zilberman and Horton references provided in the Amendment filed on January 14, 2009.

On page 8 of the Office Action, the Examiner asserts that

It would have been obvious to one of ordinary skill in the art to extend Ball’s depiction of changes occurring in text data to that of numerical data to achieve the predictable result of highlighting changes in a document. Moreover, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate Ball’s indication of text tabular delta data to the graphical user interface in Gay’s system for storing the differences between financial documents in a database because it enables a user to view the differences between various versions of the same document.

Contrary to the Examiner’s conclusions of “obviousness” based on the Examiner’s subjective perception that “[i]t would have been obvious to one of ordinary skill in the art to extend Ball’s depiction of changes occurring in text data to that of numerical data to achieve the predictable result of highlighting changes in a document,” it is telling that it never occurred to any of Gay, Zilberman or Ball et al. to provide, for example, “numerical tabular delta data that has been added to and deleted from said second-document relative to said first-document.”

Rather than teaching or suggesting the claimed invention, Ball instead merely displays certain changes to text data only (and not numeric data), and provides no indication of numeric data that has been “added to and deleted from said second-document relative to said

first-document,” as recited in the claimed invention. Moreover, Ball, being concerned with “web repositories”—not financial documents—does not even evince any appreciation for the need to provide indicia in alignment with and corresponding to changes in financial documents, inasmuch as Ball does not display such indicia. Thus, even if one were to use the approach of Ball, it would be more difficult to read and quickly and accurately verify changes between two documents as compared to the claimed invention.

Particularly here, where the reference being relied upon does not evince any appreciation of attaining the particular objectives and/or the recited features of the claimed invention, extra care should be taken not to rely on hindsight gleaned from the present invention to declare an invention obvious on the basis of an argument that reasons that the invention is obvious because the invention can provide benefits (“enables a user to view the differences between various versions of the same document”). If that were so, Gay, Zilberman and/or Ball et al. would have described the expedients claimed by Applicants. In fact, Ball shows no recognition of the manner of providing indicia in the manner recited in the claimed invention, or the rationale for providing such indicia in the context of comparing financial documents.

The Examiner is respectfully requested to provide a prior art reference to support the Examiner’s position with regard to show it would have been obvious “to extend Ball’s depiction of changes occurring in text data to that of numerical data” (Office Action, pg. 8) pursuant to MPEP section 2144.03, or an affidavit under 37 C.F.R. § 1.104 (d)(2) detailing why it would have been obvious. In the absence of either, Applicants respectfully request withdrawal of the rejection.

Where, as here, a rejection is based on the reasoning that it would have been obvious to incorporate the benefits and features of the claimed invention in an existing system, the spectre of hindsight is at issue and the admonition of Court of Appeals for the Federal Circuit is on point: “[t]o imbue one of ordinary skill in the art with knowledge of the invention [in suit], when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”. See, *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1543, 220 USPQ 303, 312-313 (Fed. Cir. 1983).

Indeed, the Examiner's reasoning on page 8 of the Office Action—that it “would have been obvious to one of ordinary skill in the art to extend Ball's depiction of changes occurring in text data to that of numerical data to achieve the predictable result of highlighting changes in a document”—only serves to underscore the nonobviousness of the present invention. Ball et al. also dealt with the subject of identifying certain changes between two documents. Yet nowhere does Ball et al. disclose the expedients which the Examiner considers to have been obvious to include. Certainly one assumes that Ball et al. were persons of at least ordinary skill in the art. Still, they failed to describe feature which the Examiner contends would have been obvious and highly beneficial to provide.


Figure 5 from Applicants' specification is provided below.

FIGURE 5 **FORM 10-Q Delta Report**

Pfizer - Form 10Q for the quarterly period ended September 29, 2002	10Q June 30, 2002
<p>DISCONTINUED OPERATIONS 46A</p> <p>Income from discontinued operations, net of tax, of \$37 million in the first nine months of 2001 reflects the resolution of several post-closing matters associated with the divestiture in prior years of the Medical Technology Group and the Food Science Group.</p> <p>FINANCIAL CONDITION, LIQUIDITY AND CAPITAL RESOURCES</p> <p>Our net financial asset position was as follows:</p> <p>[TABLE OMITTED: NET FINANCIAL ASSET POSITION]</p> <p>Selected measures of liquidity and capital resources:</p> <p>[TABLE OMITTED: SELECTED MEASURES OF LIQUIDITY AND CAPITAL RESOURCES]</p> <p>The increase in working capital from December 31, 2001 to September 29, 2002 primarily reflects:</p> <ul style="list-style-type: none"> • cash from current period operations and long-term debt issuances <p>partially offset by:</p> <ul style="list-style-type: none"> • purchases of property, plant and equipment (\$1,259 million) • purchases of our common stock (\$4,726 million) • cash dividends on common stock (\$2,382 million) <p>The increase in shareholders' equity per common share is primarily due to net income in excess of dividends declared and/or paid.</p>	<p>46B</p> <p>50</p> <p>49</p> <p>48</p> <p>ES¹ purchases of property, plant and equipment (\$1,259 million)</p> <p>ES² purchases of long-term investments (\$1,259 million)</p> <p>ES³ purchases of our common stock (\$4,726 million)</p> <p>cash dividends on common stock (\$2,382 million)</p> <p>ES⁴ The increase in shareholders' equity per common share is primarily due to net income in excess of dividends declared and/or paid.</p>

LEGEND: = Changed text = Deleted text + = Added text

A reader can look at the single document shown in Figure 5, and immediately tell that: i) the phrase “and long-term debt issuances” is a newly added (as indicated the indicia “+81”, and numeral 49); ii) that “\$1,259 million” was substituted for “\$859 million” (as indicated by indicia , and numeral 48); and iii) the phrase “purchases of long-term

investments (\$1,338 million)” was deleted (as indicated by indicia , and numeral 47). These features of the claimed invention, indicating “indicia in substantial horizontal alignment with and respectively corresponding to and indicating a) said numerical tabular delta data that has been added to and deleted from said second-document relative to said first-document, and b) substantially each occurrence of said text delta data that has been added to, substituted in, and deleted from said second-document relative to said first-document,” as recited in the claimed invention, is not disclosed or suggested in Ball (or Gay or Zilberman or Horton). Accordingly and for at least these reasons, Applicants request the Examiner to withdraw the rejection of independent claims 1, 29 and 30 under 35 U.S.C. § 103(a), and the respective dependent claims which depend therefrom.

Further, the present application introduces in its dependent claims many additional limitations which in combination with the limitations in the main independent claims further distances these dependent claims from the prior art. It is submitted that the dependent claims help obtain further incremental improvements in achieving the aim of obtaining and providing readily ascertainable and easily identifiable changes between two financial documents. This renders all of the dependent claims nonobvious over the prior art.

Applicants have carefully reviewed the Examiner’s *Response to Arguments* which commences on page 32 of the Office Action. The issue here is not merely that Ball (allegedly) teaches outputting a modified version of a document indicative of text delta data that has been added, substituted or deleted. Rather, the claimed invention also encompasses the recognition of a particular manner (as exemplified, for example, in Figure 5 of Applicants’ specification as shown and described above) of how certain changes between two documents should be displayed—“in substantial horizontal alignment”—and a motivation for such manner of display in the context of financial documents which has not been recognized in the prior art.

Moreover, although it is believed that the independent claims were already patentable over the combination of Gay, Zilberman and Ball et al., the Applicants have amended the independent claims to further distinguish over the prior art. It is believed that the presently

amended (independent and dependent) claims render moot the Examiner's assertions regarding the prior art.

In the present invention, the inventors are not merely providing a generic way of "provid[ing] a user with versions of the differences between two documents" as asserted by the Examiner on page 32 of the Office Action, but are providing a particular manner of readily identifying changes between financial documents. This represents the replacement of several visual inferences and additional scrutiny that a user would have to engage in with the techniques disclosed, for example, in Ball and/or Horton, and provides optimization of the display to facilitate viewing of such changes by lowering operator fatigue, speeding the review process, and eliminating erroneous inferences or oversights during the course of comparing two financial documents.

One who has worked with in the financial industry in the context of comparing financial documents appreciates the frustration resulting from a having to expend significant amounts of time closely scrutinizing and comparing two similar and/or related documents. Indeed, this is precisely the situation that inventors have recognized and encountered in the past, and which the present invention addresses. The invention provides a combination of features, including a precise manner of providing and displaying indicia that streamlines the review and comparison of financial documents and thereby makes the process more efficient. Applicants do not see that any combination of the prior art discloses or suggest the combination of features recited in the present invention.

As has previously been pointed out, this precise manner of displaying differences between financial documents has not appeared in the prior art, to the best of Applicants' knowledge, and is not shown in any of the references supplied by the Examiner. The Applicants do not contend that one skilled in the art would have great difficulty in providing the capability. Rather, at the time of the invention, this had not been done before because the inventors were traversing new ground with the present invention in providing an efficient way to generate and display changes between financial documents and make these changes directly available to end users for efficient review.

Conclusion

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, that is patentable. Applicants have emphasized certain features in the claims as clearly not present in the prior art, as discussed above. However, Applicants do not concede that other features in the claims are also not missing in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why each of the claims described above are distinguishable over the cited prior art.

For the reasons advanced above, issuance of a Notice of Allowance is respectfully requested.

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Respectfully submitted,

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